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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,280	01/16/2004	Alain Tornier	14588	5143
293	7590	01/25/2006		
Ralph A. Dowell of DOWELL & DOWELL P.C. 2111 Eisenhower Ave Suite 406 Alexandria, VA 22314			EXAMINER HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/758,280	Applicant(s) TORNIER ET AL.	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/25/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: ref. #66 and #72. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it contains phrases which can be implied, such as, "...according to the invention..." and "the invention is particularly applicable...". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the acetabulum" in line 5, "its distal part" in line 5, "its proximal part" in line 6, "the distal end of the handle" in line 9, and "the longitudinal axis" in line 12. There is insufficient antecedent basis for these limitations in the claim. In addition, the limitation "at least one added endpiece" should be recited that same way throughout the claims. For example, in claim 1, line 11, rather than reciting "wherein the endpiece comprises...", the claim would be more clearly understood if it were written "wherein the at least one added endpiece comprises...".

Claim 2 recites the limitation "the whole periphery" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the whole outer face" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the deformable ring" in line 20. There is insufficient antecedent basis for this limitation in the claim. Furthermore, it is unclear if "the deformable ring", "the supple part", and "the supple ring" recited in throughout the claims are referring to the same structural limitation or different structural limitations.

Claim 7 recites the limitation "the outer and inner surfaces" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the longitudinal direction of the handle" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the longitudinal direction of the rod" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the distal end" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the acetabulum" in line 23, "its distal part" in line 24, "the longitudinal" in line 27, the inner wall in line 5, "the distal end" in line 7, and "the corresponding surface" in line 13. There is insufficient antecedent basis for these limitations in the claim. Furthermore, in claim 14, line 26, "and/or" is indefinite because it is unclear what limitation such language places on the claimed subject matter. The examiner also notes that in claim 14, line 26, the recitation "a series of endpieces...each comprising a supple ring..." could be written more clearly as "a series of endpieces...each endpiece comprising a supple ring..."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Charpenet et al. (U.S. Patent No. 5,976,148).

Charpenet et al. disclose an ancillary tool for positioning an acetabular prosthesis comprising a handle FIG. 6, ref. #11) having a distal part with a head, and a proximal part, with a surface for application of a force of impaction (FIG. 6, ref. #29), and at least one added endpiece (FIG. 4) capable of being removably connected to the distal end of the handle and defining both a face for wedging the acetabulum and an opposite face of the endpiece capable of interacting with the head of the handle. The endpiece comprises a supple ring radially deformable with respect to a longitudinal axis of the endpiece (FIG. 3, ref. #1), on which are formed the faces for wedging the acetabulum and an opposite face of the endpiece capable of interacting with the head of the handle. The ring is radially deformable over substantially the whole of its periphery. The face for wedging the acetabulum of the endpiece is constituted by substantially a whole outer face of the ring. The endpiece comprises both a supple part including the deformable ring (FIG. 3, ref. #1) and a rigid part fast with the supple part and provided with means for removable connection to the distal end of the handle (FIG. 2, ref. #9). The rigid part

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of the endpiece is constituted by a metallic insert fixed to the supple part. The deformable ring is elastically connected to a base of the supple part. The deformable ring comprises a plurality of petals (FIG. 2, ref. #2), the wedging and interaction faces being respectively constituted by the outer and inner surfaces of each of these petals. The rigid part of the endpiece defines a stop surface (FIG. 2, ref. # 16), in a longitudinal direction of the handle, for the head of the handle. The supple part of the endpiece presents at least one surface for transmission of the force of impaction between the handle and the acetabulum. The head of the handle defines a ramp surface capable of cooperating with the interaction face of the endpiece (FIG. 2, see ramped portion of ref. #21). The handle comprises a rigid rod (FIG. 7, ref. #24) on which the head is movably mounted, as well as means for driving the head with respect to the rod in a movement of translation in the longitudinal direction of the rod (col. 5, lines 43-59). The handle comprises a sleeve (FIG. 6, ref. #25), disposed coaxially to the rod and at the distal end of the handle of which the head is rigidly fixed, and the means for driving the head with respect to the rod comprise a grip screwed on the rod and connected in translation with the sleeve (FIG.2, ref. #25), this sleeve being immobilized in rotation with respect to the rod. A ring is axially interposed between the sleeve and the screwed grip (FIG. 2, ref. #7) The device is capable of performing the method for positioning an acetabular prosthesis in an anatomical or prosthetic cavity of a patient's hip using a series of endpieces (col. 4, lines 53-56).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER